

part of # 19

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: A7694

Lothar K. FABER

Appln. No.: 09/883,357

Group Art Unit: 2872

Confirmation No.: 9655

Examiner: Thong Q. NGUYEN

Filed: June 19, 2001

For: **FLUORESCENCE MICROSCOPE**

DECLARATION UNDER 37 C.F.R. § 1.132

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Neil Grossman, hereby declare and state:

1. I am a citizen of the United States of America. I am presently President and CEO of Kramer Scientific Corporation incorporated in the state of New York, with a business address of 711 Executive Blvd, Valley Cottage, NY ¹⁰⁹⁸⁹~~10198~~. I have worked in the field of optics and microscopes since 1970 [insert date]. I have retained the position as CEO and President of Kramer Scientific since 10/22/80 [insert date], during which time period the events relevant to the prosecution of U.S.P. Application No. 09/883,357 have transpired, as herein related. I have reviewed U.S.P. Application No. 09/883,357 and its file history.

2. Kramer Scientific Corporation has provided optical solutions for leaders in the fields of Biomedical & Industrial Research for more than half a century. One of our more recent solutions to problems faced in the Biomedical Field includes the combination of stereo and compound objectives as disclosed, for example, by independent claim 1 of U.S.P. Application

No. 09/883,357 (filed on June 19, 2001). This Application claims priority from Provisional Application No. 60/212,737 (filed on June 20, 2000). The invention of the aforementioned applications has been assigned by the inventor, Lothar Faber (an employee of Kramer Scientific Corporation), to Kramer Scientific.

3. The invention of the above-referenced applications enables our clients to view the same sample on the same microscope platform, either stereoscopically or compoundly and with the use of either brightfield or fluorescent illumination. These combinations of features have never been combined prior to Lothar Faber's invention as quantified by the above applications.

4. Kramer Scientific developed and now manufactures and distributes the "M2-Bio", which incorporates the invention of U.S.P. Application No. 09/883,357. The M2-Bio is a commercially successful product and fills a long-felt need of biomedical professionals. The M2-Bio allows the sample being viewed to be saved from multiple shufflings from various microscope platforms and back again, thereby keeping the sample safe and secure. In application, medical professionals use the M2-Bio for research into solutions that help those who truly need help: the child with a rare genetic condition, the person with a life-threatening disease, that person with a long-term illness . . . The M2-Bio saves medical professionals' time.

5. As previously noted, the M2-Bio is a commercially successful product. This commercial success has led others in the market to copy the invention disclosed and claimed in Application No. 09/883,357.

6. I first became aware that the M2-Bio was being copied by Leica Microsystems Inc., model MZ FLIII™ (hereinafter, the "Fluo Combi"), when I was provided with a Leica sales brochure around the date of June 2003 [insert date]. In the sales brochure, it explicitly states that the Fluo Combi was developed in large part due to the competitive pressure placed on

Leica Microsystems, Inc., by the *Kramer Scientific M2-Bio microscope*. Indeed, the sale brochure describes the M2-Bio microscope as "a thorn in our side," and makes technical comparisons between the Fluo Combi and the M2-Bio throughout.

7. A similar brochure is located on the Leica Microsystems' website at <http://www.leica-microsystems.com/WebSite/products.nsf/allids/8B953F417601BD55C1256CAD0032DE7C>. In both of the aforementioned Leica brochures, the Fluo Combi is posited as "bridging the gap between stereo and compound microscopy[.]" Clearly, it is self-evident from the technical aspects displayed in the brochures that the salient/novel features of the Kramer Scientific M2 Bio microscope are copied by the Leica Fluo Combi.

8. For instance, independent claim 1 of Application No. 09/883,357 is recited below.

1. A microscope for viewing samples stereoscopically or compoundly, said microscope comprising:
a stereo objective;
a compound objective;
an objective housing, said objective housing holding said stereo objective and said compound objective, said objective housing enabled to swap said stereo objective with said compound objective or said compound objective with said stereo objective in a viewing path of the microscope;
a microscope body;
a light for providing brightfield illumination for use with both said stereo and compound objectives; and
a light for providing fluorescent illumination for use with both said stereo and compound objectives.

9. All of the above -referenced features are clearly articulated in the technical data pages of the above-referenced Leica brochures. Indeed, while Leica positions itself as "bridging the gap between stereo and compound microscopy," the Leica Fluo Combi is only able to bridge this gap by copying the features of the invention disclosed and claimed in Application No. 09/883,357.

10. Accordingly, the above information and associated references ("the Leica brochures") are respectfully presented for the Examiner's further consideration so that Application No. 09/883,357 might be considered on the whole, in the entirety of its merits.

11. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 10/8/03

Neil Grossman
Neil Grossman,
President and CEO
Kramer Scientific Corporation